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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/549,322	10/27/95	PENNETREAU	P SLVAY-0829

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12M2/0204

EXAMINER

SIEGEL, A

ART UNIT PAPER NUMBER

1204

18

DATE MAILED:

02/04/97

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 10/27/95

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-20 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-20 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

BEST AVAILABLE COPY

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Art Unit: 1204

Claims 1-20 are rejected under 35 U.S.C. § 103 as being unpatentable over Wairaevens et al ('474) in view of Rao (WO 89/12614) and further in view of Lovelace.

Wairaevens et al disclose a liquid phase process wherein vinylidene chloride is reacted with HF in the presence of a liquid medium which is a saturated halogen containing hydrocarbon under conditions of temperature and pressure included by the instantly claimed process and further discloses the relative amounts of solvent and reactants required by the instant claims. (See the claims and Examples)

Wairaevens et al differ from the instantly claimed process only in the use of a different and analogous starting material.

The application of the old process of Wairaevens et al to the analogous starting material of the instantly claimed process to obtain a result consistent with the teaching of Wairaevens et al would have been obvious to one of ordinary skill in the art.

The starting material of the claimed process and that of Wairaevens et al are analogous in that both are chlorine containing olefins wherein the chloro group is adjacent to the unsaturation.

The result obtained by Wairaevens et al is consistent with the result obtained by the claimed process in that in both cases a fluorine group replaces one chloro group and a saturated product is produced.

The motivation for using the analogous starting material of the claimed process in the Wairaevens et al process is derived from the reasonable expectation of obtaining a known useful product.

The disclosure of Rao illustrates the fact that the starting materials are analogous in that vinyl chloride and vinylidene chloride are both preferred starting materials in a similar liquid phase reaction with HF to produce analogous products. (col. 3, lines 6+).

Lovelace discloses the reaction of vinyl chloride with HF to produce 1-chloro-1-fluoroethane and indicates that the use of excess HF will result in the 1,1-difluoroethane product. Thus, Lovelace supports what would be immediately apparent to one of ordinary skill in the art that vinyl chloride is analogous to vinylidene chloride in typical hydrofluorination procedures.

Furthermore, In re Ochiai, 37 USPQ2d 1127 (Fed. Cir. 1995), supports the instant rejection in stating "the Board erred in upholding the examiner's rejection...when neither the particular cephem produced is either taught or suggested by the art that predates the parent application". It is clear therefore, that in the instant situation where both the product produced and the starting material utilized were both "taught or suggested by the art that predates the parent application" that the reasoning in In re Ochiai for reversing the Board does not apply.

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Applicants arguments have been carefully considered but are not deemed pertinent to the new ground of rejection. This is so in view of the fact that the sole relevant issue is the obviousness of using the instantly claimed starting material in the prior art process and the newly cited Lovelace specifically addresses this point.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Siegel whose telephone number is (703) 308-4692. The Examiner's normal tour of duty is Monday-Friday from 6:30 AM to 3:00 PM. Any inquiry of a general nature or relating to the status of this application should be directed to the Group 1200 receptionist whose telephone number is (703) 308-1235. The Examiner's supervisor, Gary Geist, may be reached at (703) 308-1701. Communications may now be transmitted via FAX directly to Group 1200. The official Group 1200 FAX machine number is (703) 308-4556.

A.M.S.
January 28, 1997

A handwritten signature in black ink, appearing to read 'AMS', is positioned above the typed name of the examiner.

**ALAN M. SIEGEL
PRIMARY EXAMINER
ART UNIT 1204**